

Mail Stop Appeal Brief - Patents
Appeal Brief Under 37 C.F.R. § 41.37

PATENT APPLICATION
Attorney Docket No. 2022.PC

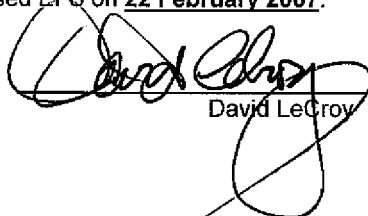
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICANTS: LEBLANC, Jean-Pierre *et al.*
SERIAL NO.: 10/813 153 **GROUP ART UNIT:** 1615
FILED: 30 March 2004 **EXAMINER:** VENKAT, Jyothsna A.
ENTITLED: USE OF SOLUBILIZED ANIONIC POLYURETHANES IN SKIN
CARE COMPOSITIONS

CERTIFICATE of TRANSMISSION UNDER 37 C.F.R. § 1.8

I hereby certify that this correspondence is being facsimile transmitted to the United States Patent and Trademark Office via the USPTO web-based EFS on 22 February 2007.



David LeCroy

Mail Stop Appeal Brief - Patents
Commissioner for Patents
Post Office Box 1450
Alexandria, Virginia 22313-1450

APPEAL BRIEF UNDER 37 C.F.R. § 41.37

Dear Sir:

In compliance with the requirements of 37 C.F.R. § 41.37(c), Appellants respectfully submit their brief in furtherance of the Notice of Appeal, which was transmitted to the United States Patent and Trademark Office on 18 July 2006.

I. REAL PARTY IN INTEREST

National Starch and Chemical Investment Holding Corporation is the owner of the entire right, title and interest in and to the invention described in this patent application by virtue of an Assignment from the inventor, which Assignment was recorded in the United States Patent and Trademark Office on 17 June 2002 at Reel 013004, Frame 0438.

II. RELATED APPEALS AND INTERFERENCES

With respect to all other prior and/or pending appeals, interferences or judicial proceedings that will directly affect or be directly affected by or have a bearing on the Board's decision in this appeal, there are no such appeals or interferences known to Appellant, Appellant's legal representative or assignee.

III. STATUS OF CLAIMS

Claims 17-20 and 22-28 are pending in this application. Claims 1-16, 21, 29 and 30 have been cancelled. Claims 17-20 and 22-28 stand rejected. No claims have been allowed.

The claims on appeal are claims 17-20 and 22-28, which are set forth in the attached Claims Appendix.

IV. STATUS OF AMENDMENTS

All claims stand as amended in Applicant's Reply of 2 November 2005, and as entered in the Examiner's final Office Action of 18 January 2006.

V. SUMMARY OF CLAIMED SUBJECT MATTER

The following summary of the subject matter defined in each of the independent claims involved in the Appeal is offered to enable the Board to more quickly determine where in the application enabling embodiments of the claimed subject matter are described. However, because other embodiments may fall within the scope of the claims, this summary should not be construed as limiting of the claims hereafter discussed.

Claim 17 is the only pending independent claim, with remaining claims 18-20 and 20-28 depending directly or indirectly from those claims. For quick reference, claim 17 is as follows –

17. A method of treating skin comprising applying to the area of skin to be treated a skin care composition comprising a neutralized, solubilized anionic polyurethane and at least one solvent.

From the above independent claim it is seen that the present invention is generally directed towards a method of treating skin comprising applying to the skin a skin care composition comprising a neutralized, solubilized anionic polyurethane and at least one solvent (p. 2, lines 3-5; p. 3, lines 10-11; p. 5, lines 1-2 of the Substitute Specification filed with the Office on 12 July 2004). In one aspect, the skin care composition can also include other polymers (p. 2, line 20 – p. 3, line 7 of the Substitute Specification).

As previously pointed out, the foregoing summary of the invention has been provided only for purposes of aiding the Board in locating at least an exemplary embodiment of the claimed subject matter within the specification. However, it is also understood that other possible embodiments as may exist within the specification may have been omitted. Compliance with this requirement, therefore, should not be applied to limit the claims.

VI. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

The grounds of rejection presented for in this Appeal are:

- (a) Claims 17-20 and 22-28 stand rejected under 35 U.S.C. § 112, first paragraph as failing to comply with the written description requirement.

VII. APPELLANT'S ARGUMENTS

A. REJECTION UNDER 35 U.S.C. § 112, FIRST PARAGRAPH

Claims 17-20 and 22-28 stand rejected as failing to comply with the written description requirement. For the following reasons, Applicants respectfully request reconsideration of the Examiner's final rejection of claims 17-20 and 22-28 under 35 U.S.C. § 112, first paragraph.

1. The "Written Description" Requirement

The initial burden of establishing a rejection for failing to meet the description requirement of § 112, first paragraph, must be carried by the Examiner. *In re Alton*, 76 F.3d 1168, 1175, 37 USPQ2d 1578, 1583 (Fed. Cir. 1996). An *ipsis verbis* disclosure is not necessary to satisfy the written description requirement of § 112. Appellant must convey with reasonable clarity to those skilled in the art that, as of the filing date, Appellant was in possession of the invention as now claimed. *Vas-Cath Inc. v. Mahurkar*, 935 F.2d 1555, 1563, 19 USPQ2d 1111, 1117 (Fed. Cir. 1991). Phrase otherwise, the written description requirement is distinct from the enablement requirement and ensures that the inventor had possession of the specific subject matter claimed as of the filing date of the application –

[The f]unction of [the] description requirement is to ensure that the inventor had possession, as of the filing date of the application relied on, of the subject matter later claimed by him; to comply with the description requirement, it is not necessary that the application describe the claimed invention in *ipsis verbis*; all that is required is that it reasonably convey to persons skilled in the art that, as of the filing date thereof, the inventor had possession of the subject matter later claimed by him.

In re Edwards, 568 F.2d at 1351-52, 196 USPQ at 467 (citations omitted).

2. Claims 17-20 and 22-28 of the Present Invention Comply with the Written Description Requirement

In rejecting the claims of the present application, the Examiner stated –

There is no support in the specification for the amended expression [“to the area of the skin to be treated”]. Page 5, lines 1-2 recite” *about 0.2, most particularly at least about 0.5 and no more than about 15%, more particularly no more than about 10%, most particularly no more than about 5%, by weight of the skin care composition.*

Page 2, third paragraph of section 2 of the 18 January 2006 Office Communication.

The page cite noted by the Examiner refers to the Specification as originally filed in the present application. In that Specification, support for the amended expression “to the area of the skin to be treated” is found at page 5, lines 27-28 of the Specification. In Applicant’s 2 November 2005 Reply, reference was made to page 5, lines 1-2 of the Substitute Specification filed with the Office on 12 July 2004. Therein it states that “[t]he enhanced skin care compositions are applied in the same manner as those known in the art”.

The Examples of the present application provides different illustrative skin care compositions according to the present invention. These include, for example, hand and body moisturizing lotions, skin tightening emulsions, face creams and lotions, and sunscreens. One skilled in the art would readily understand that these skin care compositions would be applied "to the area of the skin to be treated". Although this phrase is not an *ipsis verbis* rendering of the language found at page 5 of the present Specification, applying to the area to be treated would be within the ordinary knowledge of one skilled in the art. Further, the Examples illustrate application of a skin care composition to Vitro-Skin[®] in order to assess the effect of the composition on an area of skin against other areas of the skin that are not treated. Accordingly, the originally filed disclosure conveys with reasonable clarity to those of ordinary skill in the art that Appellant, as of the filing date, was in possession of the invention as now claimed, that is, the treatment of skin by applying to the area to be treated a skin care composition comprising a neutralized, solubilized anionic polyurethane and at least one solvent.

For at least these reasons, Kousei does not teach or suggest with specificity each and every element of the presently claimed invention, and therefore cannot be said to anticipate it.

VIII. CONCLUSION

For the reasons mentioned above, Appellant's hair fixative composition is not anticipated by Kousei, made obvious by Kousei, or rendered obvious by Kousei in view of Bhatt, as neither reference, alone or in combination, teach hair fixative composition comprising xanthan gum that has been heat treated to a moisture content of less than 8%.

For all of the foregoing reasons, it is respectfully submitted that the final rejection of all claims is untenable and should not be sustained. Allowance of the claims is believed to be in order, and such allowance is respectfully requested.

Dated: 22 February 2007

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Respectfully submitted,



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CLAIMS APPENDIX

Claims of U.S. Application No. 10/813 153 on Appeal

17. A method of treating skin comprising applying to the area of skin to be treated a skin care composition comprising a neutralized, solubilized anionic polyurethane and at least one solvent.
18. The method of claim 17, wherein the composition further comprises a second solubilized polymer.
19. The method of claim 18, wherein the second polymer is selected from the group consisting of acrylate and methacrylate polymers.
20. The method of claim 19, wherein the second polymer is poly(meth)acrylate.
22. The method of claim 17 or 18, wherein the skin care composition is selected from the group consisting of sunscreens, suntan compositions, after-sun compositions, hand moisturizers, body moisturizers, face creams, face lotions, skin tightening compositions, skin firming compositions, skin cleansing compositions, color cosmetics, and whitening compositions.
23. The method of claim 17 or 18, wherein the amount of polyurethane or polyurethane and second polymer is at least about 0.1 wt% by weight of the composition.
24. The method of claim 23, wherein the amount of polyurethane or polyurethane and second polymer is at least about 0.2 wt% by weight of the composition.
25. The method of claim 23, wherein the amount of polyurethane or polyurethane and second polymer is at least about 0.5 wt% by weight of the composition.
26. The method of claim 17 or 18, wherein the amount of polyurethane or polyurethane and second polymer is no more than about 15 wt% by weight of the composition.

27. The method of claim 26, wherein the amount of polyurethane or polyurethane and second polymer is no more than about 10 wt% by weight of the composition.
28. The method of claim 26, wherein the amount of polyurethane or polyurethane and second polymer is no more than about 5 wt% by weight of the composition.

EVIDENCE APPENDIX

No evidence has been submitted pursuant to 37 C.F.R. §§ 1.130, 1.131 or 1.132, nor is there any other evidence entered by the Examiner and relied upon by appellant in this appeal. Therefore, no copies of such evidence are to be had for the purpose of this Appendix.

RELATED PROCEEDINGS APPENDIX

As noted in Section II of the current Appeal Brief, no decisions have been rendered by a court or the Board in any proceeding related to, directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal. Therefore, no copies of such decisions are to be had for the purpose of this Appendix.